

REMARKS

Amendments to the claims

Claims 1-17 are pending. The applicant have amended claim 8 for clarity reasons. No new matter has been added.

Claim rejections – 35 USC § 112

In Section 4 of the Action the Examiner rejects claim 8 under 35 USC § 112, second paragraph. The Applicants have replaced “said telephone function” with “a telephone function,” thus overcoming the rejection of the Examiner.

Claim rejections – 35 USC § 103

1.

In Section 6 of the Action the Examiner rejects claims 1, 2, 4-7, 9-13, and 15-17 under 35 USC § 103(a) as being unpatentable over U.S. Pat. No. 6,622,174 to Ukita and U.S. Pub. App. No. 2001/0005854 to Murata. The Applicants respectfully disagree.

Independent claims 1 and 9 recite the feature “*an email adding device for referencing said user information storage device upon receipt of each of the email messages sent from said terminals, acquiring at least one predetermined item of said user information corresponding to users using said terminals, and adding said item of said user information to the email message.*”

In order to reach that feature, the Examiner combines Ukita with Murata. The information used in Ukita is advertisement information based on information on the user receiving the message (column 11, lines 5-14 of Ukita). The information used in Murata is user information (paragraphs 0052 to 0054 of Murata).

Why would a person skilled in the art looking at Ukita be motivated to replace advertisement information based on user information with user information? In other words, Ukita is concerned with sending advertisement content which is a function of the profile of the user receiving a message, so why would a person skilled in the art be motivated to replace that with personal information about a user? The problem solved

in Ukita is that of sending advertisement, the advertisement being necessarily related to personal data associated with the user receiving the message. The problem in Murata is different, i.e. it concerns user information related to a place, the place being unrelated to personal data associated with the user receiving the message. As a consequence, the person skilled in the art would not be motivated to combine Ukita with Murata.

In section 7 of the Action, the Examiner argues that the motivation is to 'improve the convenience and effectiveness of positional data added to email.' However, doing so would defeat the object of Ukita, where user data (which, in Ukita, would be user data on the same user receiving the e-mail) cannot and will not be sent to the user.

Therefore, the Applicants submit that the Examiner is not in a condition to make a proper 35 USC § 103 case against claims 1 and 9 based on a combination between Ukita and Murata. It follows that claims 1 and 9 are patentable, together with dependent claims 2, 4-7, 10-13 and 15-17, at least by virtue of their dependence on claims 1 and 9.

2.

In section 18 of the Action, the Examiner rejects claims 3, 8 and 14 under 35 USC § 103(a) as being unpatentable over Ukita and Murata, further in view of U.S. Pat. No. 6,192,258. The Applicants respectfully disagree and submit that claims 3 and 8 depend on claim 1 and claim 14 depends on claim 9. Therefore, the Examiner is not in a condition to make a 35 USC § 103(a) rejection against those claims for the same reasons as explained above. Therefore, claims 3, 8 and 14 are patentable over the cited art.

* * *

The Applicant submits that all claims of the application as amended herein are in condition for allowance. Prompt issuance of a Notice of Allowance is earnestly solicited.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including

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a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

I hereby certify that this correspondence is being deposited with the United States Post Service with sufficient postage as first class mail in an envelope addresses to: Mail Stop Amendments, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on

July 29, 2005
(Date of Deposit)

Susan Papp
(Name of Person Depositing)

Susan Papp
Signature
7/29/05
Date

Respectfully submitted,

Alessandro Steinfel

Alessandro Steinfel
Attorney for Applicant
Reg. No. 56,448
LADAS & PARRY
5670 Wilshire Blvd., Suite 2100
Los Angeles, CA 90036
(323)934-2300

Enclosures: - Petition for 1-month extension of time (in duplicate)
- Check in the amount of \$120
- postcard